Claim 6, line 9, after "environment", insert --and allowing said player to suppress during said session a presentation of said actual score and/or performance ~~and/or video image~~ to said backfeeding--.

REMARKS

This Amendment is being filed in response to the Office Action dated November 22, 1999. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-8 are pending in this application of which claims 1 and 6 are independent claims. Claim 5 is canceled herein, without prejudice, and the patentable elements of Claim 5 are incorporated into independent Claims 1 and 6 as amended.

In the Office Action, Claims 1-2, 4, and 6-7 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,710,873 to Breslow ("Breslow"). Claims 3 and 8 are rejected under 35 U.S.C. §103(a) as unpatentable over the Breslow in view of U.S. Patent No. 4,521,014 to Sitrick ("Sitrick"). Claim 5 is rejected under 35 U.S.C. §103(a) as unpatentable over the Breslow in view of U.S. Patent No. 5,657,246 to Hogan ("Hogan") or U.S. Patent No. 5,821,983 to Weiss ("Weiss").

Breslow discusses a video game that operates to capture an image of a video game player and provides for the display of the video game player in a scoring display format. Hogan is in a non-analogous art of video conferencing and discusses that a video image of a video conferencing participant may be suppressed. Weiss is in the non-analogous art of video telephones and provides that a user may override "data message re-transmission" (see, Col. 5, lines 53-61). It is the Applicants position that a person of ordinary skill in the art would not be motivated to incorporate the teaching of Hogan or Weiss into Breslow.

Accordingly, it is inappropriate to combine the teachings of Breslow with the teachings of Hogan or Weiss. Clearly, Breslow, Hogan, and Weiss are concerned with very different and unrelated problems. The suggestion in the Office Action that the combination of Breslow with either of Hogan or Weiss "would be obvious to one having ordinary skill in the art ... to include the supression feature of Hogan et al or Weiss in the invention of Breslow" is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst unrelated prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary

skill in the art. (See, In re Rouffet, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine Breslow with either of Hogan or Weiss. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, In re Rouffet, 1458).

Further, even in combination, Breslow together with either of Hogan or Weiss does not disclose or suggest (emphasis provided) "allowing said player to suppress during said session a presentation of said actual score, performance and/or video image to said backfeeding" as required by Claims 1 and 6. Accordingly, Claims 1 and 6 are patentable over any combination of Breslow together with either of Hogan or Weiss. Claims 2,3, 5 and 7-8 depend from one of Claims 1 and 6 and are therefore, also patentable for at least that reason.

Based on the foregoing, the Applicants respectfully submit that Claims 1-4 and 6-8 are patentable over the prior art of record and notice to this effect is earnestly solicited. The Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

By _____
Gregory L. Thorne, Reg. No. 39,398
Attorney
(914) 333-9665
February 22, 2000

CERTIFICATE OF MAILING

It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

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By Noemi Chapa
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